RECORD AND BRIEFS 159

(2) SUPREME COURT, U.S. FILED
09-778 DEC 21 2009
No. OFFICE OF THE CLERK

IN THE
Supreme Court of the United States

SAINT-GOBAIN CORPORATION,

Petitioner,

v.

GEMTRON CORPORATION,

Respondent.

On Petition for a Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

ARTHUR I. NEUSTADT
JEAN-PAUL LAVALLEYE
BARRY J. HERMAN
Counsel of Record
MICHAEL E. MCCABE, JR.
ROBERT C. NISSEN
OBLON, SPIVAK, MCCLELLAND,
MAIER & NEUSTADT, L.L.P.
1940 Duke Street
Alexandria, VA 22314
(703) 413-3000

Counsel for Petitioner

Library of Congress
Law Library

QUESTION PRESENTED FOR REVIEW

Whether the United States Court of Appeals for the Federal Circuit impermissibly applied United States patent law on an extraterritorial basis in upholding a finding of infringement of a product claim based on a temporary characteristic of the product during its manufacture in Mexico, even though the product found to infringe no longer had this characteristic when imported into the United States?

PARTIES TO THE PROCEEDINGS AND CORPORATE DISCLOSURE STATEMENT

The parties to this proceeding are Petitioner/Appellant Saint-Gobain Corporation and Respondent/Appellee Gemtron Corporation.

Saint-Gobain Corporation states that Compagnie de Saint-Gobain is the parent of Saint-Gobain Corporation.

TABLE OF CONTENTS

QUESTION PRESENTED FOR REVIEW i

PARTIES TO THE PROCEEDINGS AND CORPORATE DISCLOSURE STATEMENT ii

TABLE OF CONTENTS iii

TABLE OF AUTHORITIES v

PETITION FOR *CERTIORARI* 1

OPINION BELOW 1

JURISDICTION 1

STATUTORY PROVISION INVOLVED 1

STATEMENT OF THE CASE 2

A. Introduction 2

B. Proceedings Below 4

REASONS FOR GRANTING THE PETITION 6

I. The Opinion Below Conflicts With This Court's Precedent on the Extraterritorial Limits of United States Patent Law 6

II. The Federal Circuit Improperly Found that Saint-Gobain's Refrigerator Shelves Infringe the Asserted Patent Even Though Those Products No Longer Include the Supposedly Infringing Feature While in the United States 8

CONCLUSION 13

APPENDIX

A. Opinion of the United States Court of Appeals for the Federal Circuit (July 20, 2009) 1a

B. District Court's Memorandum and Order Denying Saint-Gobain's Rule 50 Motion For Judgment As A Matter of Law (April 21, 2008) 22a

C. District Court's Opinion and Order on Parties' Renewed Motions for Partial Summary Judgment (April 17, 2006) 56a

D. Order from United States Court of Appeals for the Federal Circuit Denying Petition For Rehearing En Banc (October 9, 2009) 71a

TABLE OF AUTHORITIES

Cases

Biotec Biologische Naturverpackungen GmbH v. Biocorp, Inc.,
249 F.3d 1341 (Fed. Cir. 2001) 9, 12

Brown v. Duchesne,
60 U.S. 183 (1857) 6, 11, 12

Deepsouth Packing Co. v. Laitram Corp.,
406 U.S. 518 (1972) 6, 11

Dowagiac Mfg. Co. v. Minnesota Moline Plow Co.,
235 U.S. 641 (1914) 2, 10

Eli Lilly v. Am. Cyanamid,
82 F.3d 1568 (Fed. Cir. 1996) 10

F. Hoffman-La Roche Ltd. v. Empagran S.A.,
542 U.S. 155 (2004) 11

Gemtron Corp. v. Saint-Gobain Corp.,
572 F.3d 1371 (Fed. Cir. 2009) 1

In re Northern Pigment Co.,
71 F.2d 447 (CCPA 1934) 9, 10

Mannington Mills, Inc. v. Congoleum Industries, Inc.,
610 F.2d 1059 (3d Cir. 1979) 9

Microsoft Corp. v. AT&T Corp.,
550 U.S. 437 (2007) 6, 11

NTP, Inc. v. Research in Motion, Ltd.,
418 F.3d 1282 (Fed. Cir. 2005) 12

Pellegrini v. Analog Devices, Inc.,
375 F.3d 1113 (Fed. Cir. 2004) 12

Statutes

28 U.S.C. § 1254(1) 1

35 U.S.C. § 271(a) ..... *passim*

35 U.S.C. § 271(f) 6, 11, 12

35 U.S.C. § 271(g) ..... *passim*

Other

Stephanie N. Mahlin: *How Far is Too Far? The United States Supreme Court Restrains the Extraterritorial Reach of 35 U.S.C. § 271(f) Over Software Exports in* Microsoft v. AT&T Corp., *127 S. Ct. 1746 (2007)*, 87 Neb. L. Rev. 301, 320 (2008) 6

Jacob A. Schroeder, *So Long As You Live Under My Roof, You'll Live By ... Whose Rules?: Ending the Extraterritorial Application of Patent Law*, 18 Tex. Intell. Prop. L.J. 55, 81 (Fall, 2009) 7

PETITION FOR *CERTIORARI*

OPINION BELOW

The opinion of the United States Court of Appeals for the Federal Circuit (App., *infra*, 1a-21a) is reported at *Gemtron Corp. v. Saint-Gobain Corp.*, 572 F.3d 1371 (Fed. Cir. 2009). The opinion denying the petition for rehearing en banc (App., *infra*, 71a-72a) was not reported. The opinion of the district court denying Saint-Gobain Corporation's ("Saint-Gobain") Rule 50 motion for judgment as a matter of law (App., *infra*, 22a-55a) was not reported. The opinion of the district court granting Gemtron Corporation's ("Gemtron") motion for partial summary judgment of infringement (App., *infra*, 56a-70a) was not reported.

JURISDICTION

The judgment of the Federal Circuit was entered on July 20, 2009. The decision of the Federal Circuit denying a petition for rehearing *en banc* was issued on October 2, 2009. The basis for this Court's jurisdiction is 28 U.S.C. § 1254(1).

STATUTORY PROVISION INVOLVED

Article 35, Section 271(a) of the United States Code states:

(a) Except as otherwise provided in this title, whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States or imports into the United States any patented

invention during the term of the patent therefore, infringes the patent.

STATEMENT OF THE CASE

A. Introduction

The Court has explained that "[t]he right conferred by a patent under our law is confined to the United States and its Territories." *Dowagiac Mfg. Co. v. Minnesota Moline Plow Co.*, 235 U.S. 641, 650 (1914). The Federal Circuit's decision is inconsistent with this precedent since it permits a temporary characteristic of the product during its manufacture in Mexico to be the basis for infringement of a product patent, even though the product found to infringe no longer has this physical characteristic upon importation into the United States. Therefore, the Court should grant the petition for *certiorari* and reverse the Federal Circuit's improper expansion of United States patent law to foreign countries.

The patent at issue in this case is United States patent 6,679,573 (the '573 patent).[1] The invention is directed to a refrigerator shelf consisting of a glass panel in a plastic frame (and its support in a refrigerator).

Claim 23 of the '573 patent recites a refrigerator shelf comprising a plastic frame and a glass panel that can be joined together by virtue of the frame's

---

[1] Gemtron also asserted infringement of the parent to the '573 patent, United States patent 6,422,673 ("the '673 patent"), although the '673 patent is not at issue here. The '573 and '673 patents have the same specification and drawings.

flexible (*i.e.*, "relatively resilient") fingers (also called "end edge portions"). These flexible fingers allow the glass to be snap-fit into the frame. More specifically, claim 23 requires "a relatively resilient end edge portion which temporarily deflects and subsequently rebounds to snap-secure" the glass into the frame.[2]

The allegedly infringing refrigerator shelves are made in Mexico by a heat shrink process in which a glass panel is inserted into a plastic frame which is still warm from the injection molding process and before it cools and becomes rigid.

At trial, Gemtron offered, as evidence of alleged infringement, a videotape of Saint-Gobain's manufacturing process in Mexico. As asserted by Gemtron, the videotape shows that the frame of the accused Saint-Gobain shelf was manufactured by an injection molding process. After the frame was removed from the injection molding machine, the "fingers" of the frame were "resilient" (or flexible) for a relatively short period until the frame cooled. During that brief time period after the frame was formed, its "fingers" were allegedly flexible enough

---

[2] The patent specifies no need for any other condition (such as heating) to snap-fit the glass into the frame. The fingers are also flexible at refrigerator temperatures. The patent repeatedly warns that the fingers remain flexible after the glass panel is inserted into the frame, including when the shelf is used in a refrigerator and is subject to food loading. Accordingly, the patent instructs that the fingers of the frames must be supported by ribs or ledges in the refrigerator compartment; without the support provided by the ribs or ledges, the fingers could deflect when the shelf is loaded with food, which could cause the glass panel to be pushed out of the frame.

that they temporarily deflected and rebounded to snap secure the glass panel into the frame. The plastic frame rapidly cooled and contracted and the "fingers" of the frame were no longer "resilient" or flexible. When imported into the United States, the fingers on the frame of the Saint-Gobain shelf were no longer "relatively resilient" and could not "deflect and rebound" as required by claim 23.

Thus, the issue in this case is whether the Federal Circuit was correct in expanding the reach of United States patent law to cover Saint-Gobain's refrigerator shelves, which have "resilient fingers" that can "deflect and rebound" only while they are in a temporary heated state during manufacture of the refrigerator shelf in Mexico -- the fingers are not resilient when the shelves are imported into the United States.

B. Proceedings Below

At trial below, the issue for the jury was whether Saint-Gobain's accused refrigerator shelf infringed product claim 23 of the '573 patent under 35 U.S.C. § 271(a). Gemtron did not assert any other statutory basis for infringement.

The issue concerning infringement was whether the "end edge portion" or "finger" of the frame of the Saint-Gobain refrigerator shelf was "relatively resilient." The district court held on summary judgment that certain of Saint-Gobain's shelves infringed claim 23 of the '573 patent. App., *infra*, 56a-70a. After a change of judges, the second judge adopted the first judge's claim construction.

A jury trial was then held, in which the jury found that certain other Saint-Gobain shelves infringed claim 23 of the '573 patent. The jury also found that claim 23 would not have been obvious. The district court denied Saint-Gobain's Rule 50 motion for judgment as a matter of law. App., *infra*, 22a-55a.

The Federal Circuit affirmed, expanding the reach of 35 U.S.C. § 271(a) to cover Saint-Gobain's refrigerator shelf whose "fingers" were asserted to "deflect" and "rebound" only while the shelf was being manufactured in a foreign country. App., *infra*, 1a-21a.[3] The Federal Circuit's decision was based on its conclusion that the temporary presence, outside of the United States, of the claimed "deflect" and "rebound" feature was sufficient to trigger liability under 35 U.S.C. § 271(a), notwithstanding the fact that the Saint-Gobain product *as imported into the United States* could no longer "deflect" and "rebound."

---

[3] Importantly, Gemtron asserted that claim 23 is a product claim and not a product-by-process claim, and did not assert infringement under 35 U.S.C. § 271(g). The Federal Circuit held that "[o]ur construction therefore does not transform the 'relatively resilient' limitation of claim 23 into a product-by-process limitation." App., *infra*, 15a.

REASONS FOR GRANTING THE PETITION

I. The Opinion Below Conflicts With This Court's Precedent on the Extraterritorial Limits of United States Patent Law

The Court's precedent has long been that the patent laws do not "operate beyond the limits of the United States ... [such that] the use of [a product] outside of the jurisdiction of the United States is not an infringement of [the patentee's] rights, and he has no claim to any compensation for the profit ... the party may derive from it." *Brown v. Duchesne*, 60 U.S. 183, 195-96 (1857); *accord Deepsouth Packing Co. v. Laitram Corp.*, 406 U.S. 518, 531 (1972); *Microsoft Corp. v. AT&T Corp.*, 550 U.S. 437, 444 (2007).

Numerous commentators have seen the wisdom of the Court's precedent. As one commentator noted, "U.S. [patent] laws should not directly regulate activities that are wholly foreign because that would usurp some of the foreign country's power, and possibly lead to discord between the U.S. and the foreign country." Stephanie N. Mahlin: *How Far is Too Far? The United States Supreme Court Restrains the Extraterritorial Reach of 35 U.S.C. § 271(f) Over Software Exports in* Microsoft v. AT&T Corp., *127 S. Ct. 1746 (2007)*, 87 Neb. L. Rev. 301, 320 (2008).

The Federal Circuit, however, has now applied United States patent law extraterritorially. If the Court does not grant this petition, the holding below will have a negative impact on international commerce by extending the geographical scope of the

protection afforded to United States product patents beyond that lawfully provided by the Patent Act. Such an "[e]xtraterritorial [application of United States Patent Law] fails because it creates friction between States, discourages the development of national patent systems, and is unpredictable." Jacob A. Schroeder, *So Long As You Live Under My Roof, You'll Live By ... Whose Rules?: Ending the Extraterritorial Application of Patent Law*, 18 Tex. Intell. Prop. L.J. 55, 81 (Fall, 2009).

Thus, the Federal Circuit's decision will have a chilling effect on international commerce. It creates confusion as to the applicability of the long-standing legal tenet against extraterritoriality of United States patent law and makes it difficult, if not impossible, for foreign companies to plan manufacturing processes without the fear of running afoul of United States patent law. Indeed, in light of its holding, a United States product patent holder will be able to assert that a foreign-made product violates 35 U.S.C. § 271(a) based not on the condition of the manufactured product as it exists in the United States but, rather, based on a temporary condition of that product as it is being manufactured *outside* of the United States. The ruling of the Federal Circuit thus results in an inappropriate extension of the geographically limited protection afforded by United States patents and could lead to great uncertainty and financial inefficiencies for companies competing in today's global economy.

II. The Federal Circuit Improperly Found that Saint-Gobain's Refrigerator Shelves Infringe the Asserted Patent Even Though Those Products No Longer Include the Supposedly Infringing Feature While in the United States

In this case, the Federal Circuit upheld a finding of infringement even though the fingers of the Saint-Gobain refrigerator shelf were no longer able to deflect and rebound while in this country. *See* App., *infra*, 18a ("Properly construed, the 'relatively resilient' limitation requires no more than that the frame of the claimed shelf has the structural characteristic of *having been temporarily deflected and subsequently rebounded to snap-secure the glass at the time of manufacture.*") (emphasis added). Since the manufacture of the Saint-Gobain refrigerator shelf occurred in Mexico, the Federal Circuit expanded United States patent law by holding that the shelf infringed a product claim because it carried with it the history of how it was made in a foreign country.

In particular, the Federal Circuit upheld the finding of infringement based upon a videotape of the Saint-Gobain manufacturing process which took place in Mexico. Allegedly, the process showed that, while the glass is being inserted into the plastic frame, when the frame is still warm, the fingers were "relatively resilient" such that they temporarily deflected and subsequently rebounded to snap-secure the glass into the frame. The Federal Circuit upheld this finding of infringement even though when the

shelves are in this country, the fingers are rigid and cannot deflect and rebound.

Previous to this case, the Federal Circuit held that "[i]nfringement of product claims by an imported product *requires that the product be viewed in the form in which it is present within the United States.*" [4] *Biotec Biologische Naturverpackungen GmbH v. Biocorp, Inc.*, 249 F.3d 1341, 1350 (Fed. Cir. 2001) (emphasis added). In this case, there was no dispute that the Saint-Gobain shelves were made in Mexico and imported into the United States; the frames as imported are rigid and inflexible and not relatively resilient.

The Federal Circuit's analysis does not withstand scrutiny. To support its decision, the Federal Circuit *sua sponte* cited to *In re Northern Pigment Co.*, 71 F.2d 447, 456 (CCPA 1934) for the proposition that "[e]ven if an infringing product is manufactured outside of the United States, a person infringes if he imports the product, or uses, offers to sell, or sells it in the United States." App., *infra*, 18a. *Northern Pigment* was an appeal from the United States Tariff Commission, the predecessor to the International Trade Commission, and involved an alleged violation of 19 U.S.C.A. § 1337.[5] *Id.* at 450-51,

---

[4] In addition, prior to the formation of the Federal Circuit, the regional circuits also followed the Court's precedent and found that "United States patents give [the patentee] no legal power to limit foreign manufacture." *Mannington Mills, Inc. v. Congoleum Industries, Inc.*, 610 F.2d 1059, 1067 (3d Cir. 1979).

[5] Prior to the enactment of § 271(g), the only avenue for a United States patent holder to stop infringement of a product

and n.1 (affirming the Commission's finding that the accused infringer manufactured iron oxides "in accordance with the process described" in one of the patents-in-suit and that "the importation into the United States or the sale in the United States by the owner . . . of such iron oxides" violates Section 337).

The Federal Circuit found infringement here under 35 U.S.C. § 271(a), not § 271(g) (Gemtron did not assert infringement under § 271(g)). Thus, *Northern Pigment* does not provide support for the Federal Circuit's holding because that appeal from the United States Tariff Commission, at best, would provide support for Gemtron if it had asserted infringement under § 271(g).

The Federal Circuit's new expanded liability theory cannot be reconciled with the Court's binding precedent that "the right conferred by a patent under our law is confined to the United States and its Territories . . . and infringement of this right cannot be predicated of acts wholly done in a foreign country." *Dowagiac Mfg. Co. v. Minn. Moline Plow Co.*, 235 U.S. 641, 650 (1915). As the Court explained, "[o]ur patent system makes no claim to extraterritorial effect; 'these acts of Congress do not,

---

made by a patented process was to bring suit in the International Trade Commission. *See Eli Lilly v. Am. Cyanamid*, 82 F.3d 1568, 1571 (Fed. Cir. 1996) (noting that, prior to the enactment of the Process Patent Amendments Act of 1988, "a patentee holding a process patent could sue for infringement if others used the process in this country, *but had no cause of action if such persons used the patented process abroad to manufacture products, and then imported, used, or sold the products in this country*") (emphasis added).

and were not intended to, operate beyond the limits of the United States,' and we correspondingly reject the claims of others to such control over our markets." *Deepsouth*, 406 U.S. at 531 (quoting *Brown*, 60 U.S. at 195-96).

More recently, in *Microsoft*, 550 U.S. at 441, the Court reaffirmed "the general rule under United States patent law that no infringement occurs when a patented product is made and sold in another country." The Court went on to explain that "[a]s a principle of general application . . . courts should 'assume that legislators take account of the legitimate sovereign interests of other nations when they write American laws.'" *Id.* at 455 (quoting *F. Hoffman-La Roche Ltd. v. Empagran S.A.*, 542 U.S. 155, 164 (2004)). The Court further noted that, "'[f]oreign conduct is [generally] the domain of foreign law,'" and that, particularly in the area of patent law, "foreign law may embody different policy judgments about the relative rights of inventors, competitors, and the public in patented inventions."[6] 550 U.S. at 455 (internal quotation marks omitted).

---

[6] There are two exceptions to the rule that U.S. Patent law does not apply abroad, neither of which apply here. The first is under 35 U.S.C. § 271(f), which provides that infringement occurs when one "supplies ... from the United States,' for 'combination' abroad, a patented invention's 'components.'" *Microsoft*, 550 U.S. at 441.

The second exception is § 271(g), under which a product made outside of the United States by a process patented in the United States may infringe the patent when the product so made is imported, used, sold, or offered for sale in the United States, provided that the product so made is not materially changed by

Here, the Federal Circuit, on the basis of the district court's claim construction, found that a product claim can be infringed under 35 U.S.C. § 271(a) on the basis of how it was made in a foreign country even though the product as imported into the United States has no characteristics of this manufacture. However, as stated above, infringement of a product claim under 35 U.S.C. § 271(a) must be determined based on the condition of the accused product as it exists in the United States, and not upon how it temporarily existed during manufacture in a foreign country. [7]

The Federal Circuit's decision in the case below is contrary to the Court's precedent and, therefore, the Court should grant the petition for *certiorari*.

---

subsequent processes and does not become a trivial and nonessential component of another product. 35 U.S.C. § 271(g)(1)-(2). Gemtron did not assert infringement under either § 271(f) or § 271(g).

[7] As discussed *supra*, the Federal Circuit has previously held that "infringement of product claims by an imported product requires that the product be viewed in the form in which it is present within the United States." *Biotec*, 249 F.3d at 1350. In addition, the Federal Circuit has recognized that "[t]he territorial reach of section 271 is limited. Section 271(a) is only actionable against patent infringement that occurs within the United States." *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1313 (Fed. Cir. 2005), *citing Pellegrini v. Analog Devices, Inc.*, 375 F.3d 1113, 1117 (Fed. Cir. 2004) ("[As] the U.S. Supreme Court explained nearly 150 years ago in *Brown v. Duchesne* ... the U.S. patent laws 'do not, and were not intended to, operate beyond the limits of the United States.'").

CONCLUSION

For the foregoing reasons, the petition for *certiorari* should be granted.

Respectfully submitted,

Arthur I. Neustadt
Jean-Paul Lavalleye
Barry J. Herman
Counsel of record
Michael E. McCabe, Jr.
Robert C. Nissen
OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.
1940 Duke Street
Alexandria, Virginia 22314
(703) 413-3000

Counsel for Petitioner

December 31, 2009

APPENDIX

Appendix A

United States Court of Appeals for the Federal Circuit

2009-1001

GEMTRON CORPORATION,

Plaintiff-Appellee,

v.

SAINT-GOBAIN CORPORATION,

Defendant-Appellant.

Appealed from the United States District Court for the Western District of Michigan in case no. 1:04-CV-0387, Senior Judge Avern C. Cohn.

572 F.3d 1371 (Fed. Cir. 2009)

DECIDED: July 20, 2009

Before MICHEL, Chief Judge, SCHALL and LINN, Circuit Judges.

LINN, Circuit Judge.

Refrigerator parts manufacturer Saint-Gobain Corporation ("Saint-Gobain") appeals from the grant of a permanent injunction following a determination that certain of its refrigerator shelves infringe claim

23 of U.S. Patent No. 6,679,573 (the "'573 patent"), owned by Gemtron Corporation ("Gemtron"). Gemtron Corp. v. Saint-Gobain Corp., No. 1:04-387 (W.D. Mich. Sept. 22, 2008); see also Gemtron Corp. v. Saint-Gobain Corp., No. 1:04-0387 (W.D. Mich. Apr. 21, 2008); ("New Trial Op."); Gemtron Corp. v. Saint-Gobain Corp., No. 1:04-0387 (W.D. Mich. Apr. 21, 2008) ("JMOL Op. ") Saint-Gobain Corp. v. Gemtron Corp. , No. 1:04-387 (W.D. Mich. Apr. 17, 2006) ("S.J. Op. "). Because the district court correctly construed the claim term "relatively resilient end edge portion" to require only that the frame of the shelf be flexible at the time of manufacture, because there was undisputed evidence that the frames of Saint-Gobain's accused shelves were flexible at the time of manufacture, and because the district court did not err in denying Saint-Gobain's motions concerning obviousness, we affirm.

I. BACKGROUND

Gemtron is the assignee of both the '573 patent and U.S. Patent No. 6,422,673 (the "'673 patent"). The '573 patent issued from a divisional of the application that issued as the '673 patent, and the two patents share a common specification. See '573 patent, at [62]. The '573 patent is directed to a refrigerator shelf. Id. col.1 l.1. The shelf disclosed in the '573 patent is made up of two pieces—"a one-piece open frame" made of plastic, and a glass panel. Id. col.2 ll.29-33. Top and bottom views of the shelf are depicted below:

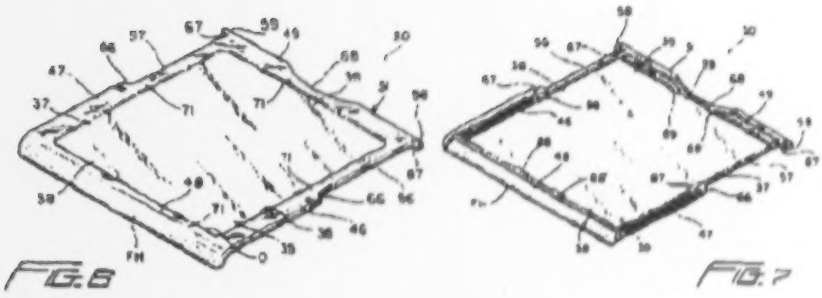


FIG. 6 FIG. 7

Id. figs. 6-7.

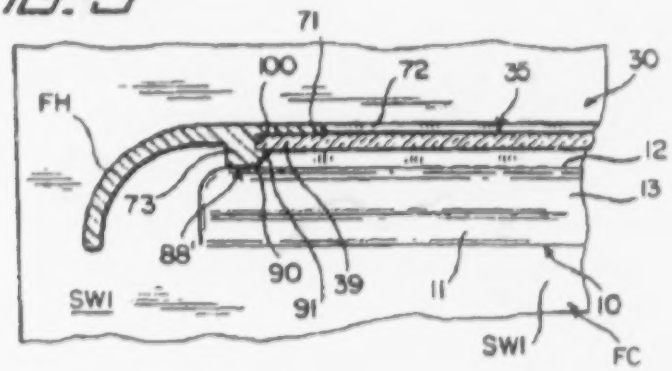
Unlike prior art shelves that were constructed by bonding the edge of the glass panel to the frame using adhesive, the claimed shelf secures the glass panel in the frame using "relatively resilient" fingers so that the glass panel is "snap-secured" into place. Id. col.2 ll.42-47. According to the specification, avoiding adhesive is desirable because using adhesive increases manufacturing costs:

> The cost of adhesive adds to the overall cost of such shelves and, of course, additional steps are required during the assembly process to apply the adhesive to the frame and/or to the edges of the glass panel prior to assembling the same. Moreover, if an overabundance of adhesive is utilized, there is a tendency for the edges of the glass panel to squeeze excess adhesive out of the continuous peripherally inwardly opening glass edge-receiving channel, and this in turn creates additional adhesive clean-up problems and the cost associated therewith.

Id. col.1 ll.46-55. By contrast, by using a frame with "relatively resilient" fingers that "snap-secure[]" the glass panel, the shelf of the '573 patent "is manufactured at a relatively low cost from only two pieces of material (a frame and a glass panel) in the absence of the added costly manufacturing step of applying adhesive and removing excess adhesive." Id. col.2 ll.43, 45-46, 59-62.

The fingers of the shelf's frame are illustrated in Figure 3 of the '573 patent:

FIG. 3



Id. fig.3. "In the assembled condition of the frame, [the edges of] the glass panel 35 are each snap-secured to the respective [portions] of the frame." Id. col.4 ll.38-43. The specification includes a description of the way in which the glass panel is inserted into the frame when the shelf is assembled:

> Due to [the] relative dimensioning [of the frame and glass panel] and the relatively flexible nature of the fingers 90 and the finger terminal edge portions

> 91 thereof, the latter are free to temporarily flex and deform as the glass panel 35 is inserted upwardly, ... which causes the fingers to temporarily deform, resulting in the edges of the glass panel 35 to essentially pass or snap into the associated channels of each finger whereupon the finger terminal free edge portions 91 rebound to their original position and interlock beneath each glass edge . . . . In this manner, each shelf is constructed of only two pieces of material, namely, the one-piece injection molded frame and the tempered glass panel retained in snap-secured relationship to each other . . . .

Id. col.5 l.57-col.6 l.4 (citations to reference characters omitted). Put another way, the fingers on the frame bend up as the glass is being inserted, then snap back into their original position to secure the glass.

Saint-Gobain brought suit against Gemtron in 2004, seeking a declaratory judgment of noninfringement and invalidity of the '573 and '673 patents. Gemtron counterclaimed for infringement, and the district court realigned the parties to make Gemtron the plaintiff.

Claim 23 of the '573 patent is the only claim at issue in this appeal. It recites:

> 23. A refrigerator shelf comprising a one-piece open frame made of substantially homogeneous

polymeric/copolymeric molded synthetic material and a piece of glass closing an opening defined by said frame; said open frame having opposite substantially parallel side frame portions and opposite substantially parallel front and rear frame portions; said glass piece having opposite substantially parallel side edges and opposite substantially parallel front and rear edges; said side, front and rear frame portions being substantially contiguous to said respective side, front and rear edges; each of said side frame portions being defined by an upper wall, a side wall depending from each upper wall and a lower wall projecting from its side wall toward an opposite side wall with the opposing lower walls being spaced from each other and each defining with an associated upper wall a glass piece side edge-receiving channel, each upper wall and lower wall having a terminal free edge, said glass piece side edges being spaced a predetermined distance from each other, said upper wall terminal free edges being spaced a predetermined distance from each other, said lower wall terminal free edges being spaced a predetermined distance from each other, the predetermined distance of the glass piece side edges being appreciably greater than the predetermined distance of said upper wall edges and only slightly greater than

> the predetermined distance between said lower wall terminal free edges whereby said glass piece side edges are captively retained in said glass piece side edge-receiving channels, and at least one lower wall of at least one of said front and rear frame portions including a relatively resilient end edge portion which temporarily deflects and subsequently rebounds to snap-secure one of said glass piece front and rear edges in the glass piece edge-receiving channel of said at least one front and rear frame portion.

'573 patent col.8 ll.32-65 (emphasis added).

Saint-Gobain does not dispute that its accused refrigerator shelves meet all of the limitations of claim 23 except the limitation requiring that the frame have the claimed "relatively resilient end edge portion." S.J. Op. at 6. The district court construed the claim term "relatively resilient end edge portion which temporarily deflects and subsequently rebounds to snap-secure" to mean that "the end edge portion is sufficiently resilient that it can temporarily deflect and subsequently rebound when glass is being inserted into the frame." Id. at 2-3.

In 2005, the parties filed cross-motions for partial summary judgment concerning infringement by Saint-Gobain model SG1, SG2, and SG3 shelves—which were the only three models of accused shelves at that time. Each party submitted the affidavit of an expert. Gemtron's expert testified that, when the

frames of the accused shelves were heated, it was possible to insert the glass panel of the accused shelves into the frame by snap-securing the panel into the receiving channel of the frame. Id. at 7-8. Saint-Gobain's expert testified that he had attempted to insert the glass panel into the frame at room temperature, but that the frame was not sufficiently flexible to allow insertion of the glass. The district court concluded that the conflicting test results did not create a factual dispute, because the testing was performed under different conditions. Id. at 7. Reasoning that "the relevant characteristic ['relatively resilient'] is defined by the patent in terms of the time of insertion, and not the time of actual use in a refrigerator or freezer compartment," the district court concluded that infringement was established by the undisputed evidence that the glass panel could be snap-secured into the frames of the accused shelves during manufacture, when the shelves were still warm from the molding process. Id. at 8-10. The district court therefore granted partial summary judgment of infringement of claims 23-30 of the '573 patent by the SG1, SG2, and SG3 shelves. Id. at 13.

Following the resolution of a discovery dispute, Gemtron identified additional Saint-Gobain shelves as accused infringing products. Pursuant to an amended scheduling order, the SG16 shelf was selected to be representative of all remaining accused shelves, and trial was set on infringement of claim 23 of the '573 patent as representative of all of the asserted claims. The case proceeded to trial on infringement and validity.

At trial, the jury heard evidence from both parties' experts, including a video showing Gemtron's expert heating the frame of the SG16 shelf and snap-securing the glass panel into it. JMOL Op. at 8. Gemtron also introduced evidence of Saint-Gobain's manufacturing process, including instructions for assembling the SG16 shelf and a video of the manufacture of the SG16 shelf in Saint-Gobain's Mexico plant. Id. at 9. The jury returned a verdict finding that the SG16 shelf infringed claim 23, and that claim 23 was not invalid.

The district court denied Saint-Gobain's post-trial motions for a new trial and judgment as a matter of law, entered judgment in Gemtron's favor, and granted and then stayed a permanent injunction. Gemtron Corp. v. Saint-Gobain Corp., No. 1:04-0387 (W.D. Mich. Sept. 22, 2008). Saint-Gobain timely appealed. We have jurisdiction pursuant to 28 U.S.C. § 1292(c)(1).

II. DISCUSSION

Saint-Gobain argues that the district court's construction of "relatively resilient" was incorrect, and that the district court erred by granting summary judgment of infringement, by denying Saint-Gobain's motion for judgment as a matter of law on infringement, by denying Saint-Gobain's motion for judgment as a matter of law on obviousness, and by denying Saint-Gobain's motion for a new trial. We review each of these determinations in turn.

A. Claim Construction

Claim construction is an issue of law, Markman v. Westview Instruments, Inc., 52 F.3d 967, 970-71 (Fed. Cir. 1995) (en banc), that we review de novo, Cybor Corp. v. FAS Techs., Inc., 138 F.3d 1448, 1456 (Fed. Cir. 1998) (en banc). We determine the ordinary and customary meaning of undefined claim terms as understood by a person of ordinary skill in the art at the time of the invention, using the methodology in Phillips v. AWH Corp., 415 F.3d 1303, 1312-19 (Fed. Cir. 2005) (en banc). "[T]he court looks to those sources available to the public that show what a person of skill in the art would have understood disputed claim language to mean. Those sources include the words of the claims themselves, the remainder of the specification, the prosecution history, and extrinsic evidence concerning relevant scientific principles, the meaning of technical terms, and the state of the art." Id. at 1314 (internal quotation marks and citations omitted).

The only disputed claim term is "relatively resilient end edge portion which temporarily deflects and subsequently rebounds to snap-secure." '573 patent col.8 ll.61-62. The district court construed this term to mean that "the end edge portion is sufficiently resilient that it can temporarily deflect and subsequently rebound when glass is being inserted into the frame." S.J. Op. at 3 (emphasis added). Saint-Gobain argues that the term should have been construed to mean that "the end edge portion is sufficiently flexible to permit the glass in the finished product to be pushed out of the frame

and pushed back into the frame." Br. for Defendant-Appellant Saint-Gobain Corp. at 25 (emphasis added). More particularly, Saint-Gobain argues that "relatively resilient" should not mean "temporarily resilient immediately after cooking in an oven and before any opportunity to cool." Id. at 26. Gemtron argues that the district court's construction was correct. The parties do not dispute that the "relatively resilient" limitation requires that the frame be flexible at some point in time. The dispute is about precisely when the frame must be flexible to satisfy the "relatively resilient" limitation.

Because neither party has identified any portion of the prosecution history or any extrinsic evidence bearing on the claim construction issues before us, we confine our analysis to the claim language and the specification. Looking first to the claim language, we note that claim 23 has no express temporal or temperature limitation requiring that the end edge portion be relatively resilient "always," or "at all temperatures," or "when in use in a refrigerator." Additionally, the claim does not merely claim a frame with an end edge portion that is "relatively resilient." The full expression recited in the claim calls for a frame with a "relatively resilient end edge portion which temporarily deflects and subsequently rebounds to snap-secure one of [the] glass piece front and rear edges in the glass piece edge-receiving channel." '573 patent col.8 ll.61-64 (emphasis added). The use of the phrase "temporarily deflects and subsequently rebounds to snap-secure" suggests that the claimed resilience of the frame need only be exhibited during assembly. The "snap-secure"

interaction of the frame and glass piece, facilitated by the "relatively resilient end edge portion," is a characteristic of the shelf that is maintained even after assembly in the claimed shelf. While the claim language ties the "relatively resilient" characteristic of the frame's edge portion to its function in the assembly of the shelf, that characteristic is nonetheless a structural attribute possessed by the claimed frame and is not a process limitation. See, e.g., In re Garnero, 412 F.2d 276, 279 (CCPA 1969) (listing similar examples of claim terms "held capable of construction as structural, rather than process, limitations").

Like the claims, the specification focuses on the characteristics of the frame that enable snap-secure assembly of the claimed shelf. In the "Background of the Invention" section, the specification describes the structure of prior art shelves by reference to the way in which the shelves are assembled. See, e.g., '573 patent col.1 ll.21-27 (describing assembly of prior art shelf as "[t]he glass [panel] is basically 'dropped-in' from above, not snapped-in from below"); id. col.1 ll.28-36 (describing other prior art shelves as "the same type shelf structure" but assembled using different methods, in which "a sheet of glass. . . is slid into opposite channels of a frame and then is locked into position" or "a panel . . . is dropped-in from above and rests upon a flange"). The specification characterizes all of the prior art as disclosing a shelf assembled by "adhesively bonding a peripheral edge of a sheet of glass to [the] frame." Id. col.1 ll.43-45. The specification goes on to criticize this type of shelf structure, because of the additional cost of the

adhesive and the "additional steps [that] are required during the assembly process." Id. col.1 ll.46-55. Likewise, in the "Brief Summary of the Invention" section, in discussing the advantages of the disclosed shelf over this prior art, the specification stresses the advantages that the claimed structure has in the manufacturing and assembly process:

> In this manner, a sliding shelf is manufactured at a relatively low cost from only two pieces of material (a frame and a glass panel) in the absence of the added costly manufacturing step of applying adhesive and removing excess adhesive, while at the same time increasing conductivity because the fingers cover but minor lower surface areas of the glass panel side, front and rear edges.

Id. col.2 ll.58-65. In fact, every time the structure of the "relatively resilient" edge portions is mentioned in the specification, it is in the context of a discussion of how that structure functions while the shelf is assembled. See id. col.2 ll.42-47 (describing "relatively resilient" ends of fingers "such that the glass panel can be snap-secured"); id. col.5 ll.57-60 ("Due to this relative dimensioning and the relatively flexible nature of the fingers 90 and the finger terminal edge portions 91 thereof, the latter are free to temporarily flex and deform as the glass panel 35 is inserted upwardly . . . ."). There is no discussion in the specification of any purpose for or value of the "relatively resilient" structural characteristic of the

end edge portions of the frame, other than to facilitate assembly of the shelf. This indicates that the end edge portions of the frame have the claimed structural characteristic—"relatively resilient"—if they are able to deflect at the time the shelf is assembled, to "snap-secure" the glass panel within the frame.

For these reasons, we affirm the district court's construction of "relatively resilient end edge portion which temporarily deflects and subsequently rebounds to snap-secure" as used in claim 23 to mean that the end edge portion must be sufficiently resilient that it can temporarily deflect and subsequently rebound when glass is being inserted into the frame.

Saint-Gobain argues that a construction requiring only that the frame deflect at the time that glass is being inserted into the frame during assembly transforms the "relatively resilient" limitation of claim 23 into a product-by-process limitation. We disagree. The limitation requires that the glass panel be "snap-secure[d]" in the frame. "Snap-secure[d]" describes the structural relationship between the glass panel and the frame, which is possessed by the claimed shelf because of the structural characteristics of the individual components. See, e.g., 3M Innovative Props. Co. v. Avery Dennison Corp., 350 F.3d 1365, 1371 (Fed. Cir. 2003) ("[E]ven words of limitation that can connote with equal force a structural characteristic of the product or a process of manufacture are commonly and by default interpreted in their structural sense . .

. ."); Hazani v. U.S. Int'l Trade Comm'n, 126 F.3d 1473, 1479 (Fed. Cir. 1997) (holding that claim is not product-by-process claim if it "describes the product more by its structure than by the process used to obtain it"); see also Garnero, 412 F.2d at 279 (noting that past-tense verbs such as "'intermixed,' 'ground in place,' 'press fitted,' 'etched,' and 'welded,' all . . . at one time or another have been separately held capable of construction as structural, rather than process, limitations."); Eric P. Mirabel, Product-By-Process Claims: A Practical Perspective, 68 J. Pat. & Trademark Off. Soc'y 3, 4-7 (1986). Defining a structural component by its functional as well as its physical characteristics is different from defining a structure solely by the process by which it is made. Our construction therefore does not transform the "relatively resilient" limitation of claim 23 into a product-by-process limitation.

B. Infringement

The district court granted summary judgment of infringement as to the SG1, SG2, and SG3 shelves. S.J. Op. at 13. "We review [the] grant of summary judgment de novo, reapplying the standard that the district court employed. Drawing all reasonable inferences in favor of the nonmovant, summary judgment is appropriate only when there is no genuine issue as to any material fact and the moving party is entitled to a judgment as a matter of law." Net MoneyIN, Inc. v. VeriSign, Inc., 545 F.3d 1359, 1365 (Fed. Cir. 2008) (citations and internal quotation marks omitted). Following the jury's verdict that the representative SG16 shelves

infringed the district court denied Saint-Gobain's motion for judgment as a matter of law, JMOL Op. at 20, and its motion for a new trial, New Trial Op. at 6. "This court reviews the denial of a motion for JMOL or a new trial under the law of the regional circuit where the district court sits . . . ." Voda v. Cordis Corp., , 536 F.3d 1311, 1318 (Fed. Cir. 2008). The Sixth Circuit "review[s] de novo a district court's denial of a motion for judgment as a matter of law." Imwalle v. Reliance Med. Prods., Inc., , 515 F.3d 531, 543 (6th Cir. 2008). The Sixth Circuit "review[s] the denial of a party's motion for a new trial for abuse of discretion." Morgan v. N.Y. Life Ins. Co., 559 F.3d 425, 434 (6th Cir. 2009).

Both at summary judgment and at trial, Saint-Gobain did not dispute that, during the manufacturing process for the accused shelves, when the glass is inserted into the frame, the frame is at a temperature such that it can temporarily deflect and subsequently rebound. At summary judgment, the district court concluded that it was undisputed that at the time of insertion, the end edge portion of the frame of the accused shelf can temporarily deflect and subsequently rebound. S.J. Op. at 8. Likewise, at trial, the jury saw a video of Saint-Gobain's manufacturing process and heard the testimony of an expert that, during the manufacturing process, "the glass panel was snapped into place in the manner called for by Claim 23." JMOL Op. at 20.

Nowhere in its briefs on appeal did Saint-Gobain dispute that—at the time its shelves are manufactured—the frame is at an elevated

temperature, such that the end edge portions of the frame can deflect to accommodate insertion of the glass. At oral argument, Saint-Gobain claimed that its products are actually assembled using a "heat-shrink process," and it denied that, during manufacture, the frame is "resiliently flexed to snap over the glass." Oral Arg. at 2:41-4:04, available at http://oralarguments.cafc.uscourts.gov/mp3/2009-1001.mp3 (Mar. 30, 2009). This argument is directly contradicted by the video evidence of Saint-Gobain's manufacturing process admitted at trial. The video unambiguously shows that, during Saint-Gobain's manufacturing process, while the frame is still warm from the molding process, a Saint-Gobain employee pushes on the frame, which temporarily deflects to accommodate the glass, then rebounds to snap-secure the glass piece in a receiving channel in the frame. Saint-Gobain's unsworn attorney argument to the contrary—made for the first time at oral argument on appeal—is not evidence and cannot rebut the video and other admitted evidence concerning Saint-Gobain's manufacturing process. See, e.g., Laitram Corp. v. Cambridge Wire Cloth Co., 919 F.2d 1579, 1583 (Fed. Cir. 1990) (criticizing parties' "reliance on attorney argument and counsel's unsworn fact statements as 'evidence'").

Saint-Gobain's only remaining argument is that the accused shelves cannot infringe because the manufacturing process occurs in Mexico, and that, by the time that the accused shelves are imported into the United States, the frames have cooled and are no longer flexible. According to Saint-Gobain, the accused shelves as imported and sold in the United

States must be modified—by heating them—to satisfy the "relatively resilient" limitation.

Claim 23 is directed to an apparatus—"[a] refrigerator shelf"—not a process. '573 patent col.8 l.32. Under 35 U.S.C. § 271(a), an accused infringer infringes an apparatus claim if it "makes, uses, offers to sell, or sells" the claimed apparatus "within the United States," or "imports [the apparatus] into the United States." Critically, it is the infringing act—making, using, offering to sell, selling, or importing—that must be within (or into) the United States. Even if an infringing product is manufactured outside of the United States, a person infringes if he imports the product, or uses, offers to sell, or sells it in the United States. See, e.g., In re N. Pigment Co., 71 F.2d 447, 456 (CCPA 1934) ("It has long been settled that articles patented in the United States cannot be manufactured abroad, imported, and sold in violation of the rights of the patentee.").

Properly construed, the "relatively resilient" limitation requires no more than that the frame of the claimed shelf has the structural characteristic of having been temporarily deflected and subsequently rebounded to snap-secure the glass at the time of manufacture. In this case, Saint-Gobain does not dispute that it has imported the accused shelves, and that it has used and sold them in the United States. The end portions of the frames of the accused shelves are "relatively resilient," as that phrase is used in claim 23, in that they were temporarily deflected and subsequently rebounded when glass was being inserted into the frame during assembly. The

accused shelves therefore satisfy the "relatively resilient end edge portion which temporarily deflects and subsequently rebounds to snap-secure" limitation of claim 23, as properly construed. Thus, there is no genuine issue as to any material fact as to infringement by the SG1, SG2, and SG3 shelves, and Gemtron was entitled to a judgment as a matter of law that those shelves infringed. Likewise, substantial evidence—in fact, uncontroverted evidence—supports the jury's verdict that the representative SG16 shelf infringes claim 23. We therefore affirm the district court's grant of summary judgment of infringement, its denial of Saint-Gobain's motion for judgment of noninfringement as a matter of law, and its denial of Saint-Gobain's motion for a new trial on infringement.

C. Validity

The district court denied Saint-Gobain's motions for judgment of invalidity as a matter of law and for a new trial on obviousness. JMOL Op. at 21-22. Applying Sixth Circuit law, we review the denial of judgment as a matter of law de novo, and the denial of Saint-Gobain's motion for a new trial for abuse of discretion. See Voda, 536 F.3d at 1318; Imwalle, 515 F.3d at 543; Morgan, 559 F.3d at 434.

Saint-Gobain's appeal of both motions boils down to a single argument: Saint-Gobain argues that the only evidence of nonobviousness was the testimony of Gemtron's expert, Roger Hamilton, who testified that a person of ordinary skill in the art would not have expected that the claimed flexible frame could be used in a shelf that would support food loading.

According to Saint-Gobain, this testimony should have been "excluded as contrary to the '573 specification." Br. for Defendant-Appellant Saint-Gobain Corp. at 35.

We reject Saint-Gobain's argument for two reasons. First, Saint-Gobain did not seek to exclude or strike Hamilton's testimony at trial. The issue is therefore waived. See, e.g., Curcuru v. Peninsular Elec. Light Co., 258 F. 785, 790 (6th Cir. 1919) (holding that objection to admissibility of testimony is waived for purposes of appeal if no motion to strike is made during trial).

Second, a shelf capable of supporting food loading is not "directly contrary to the '573 patent" as Saint-Gobain argues. Reply Br. for Defendant-Appellant Saint-Gobain Corp. at 25. Saint-Gobain is correct that the specification of the '573 patent expressly describes the ribs of the refrigerator compartment providing support to the shelf, to prevent the frame from bending and, consequentially, allowing the glass to fall out. See, e.g., '573 patent col.2 ll.53-58; id. col.6 ll.13-29. Nevertheless, the context of the specification makes clear that the shelf alone can support food loading, and that the ribs are provided as additional support to prevent inadvertent distortion of the frame. See id. col.2 l.56 (describing ribs as resisting "any tendency" that the frame might have to bend); id. col.6 l.15 (noting that each rib "assures" that frame will not distort); id col.6 ll.22 (noting that, without ribs, glass panel "might inadvertently flex" fingers of the frame); id. col.6 ll.25-26 (remarking that frame "might stress" without

ribs). The specification therefore does not contradict Hamilton's testimony that the shelf of the '573 patent was, unexpectedly, able to support food loading. Hamilton's testimony thus provided substantial evidence that a person of ordinary skill in the art would not have expected the results of the combination recited in claim 23. The district court did not err by denying Saint-Gobain's motion for judgment as a matter of law, and the district court did not abuse its discretion by denying Saint-Gobain's motion for a new trial.

III. CONCLUSION

For the foregoing reasons, we adopt the district court's construction of the claim term "relatively resilient end edge portion" to mean that the end edge portion is sufficiently resilient that it can temporarily deflect and subsequently rebound when glass is being inserted into the frame. Applying this construction, we affirm the district court's grant of summary judgment, its denial of Saint-Gobain's post-trial motions as to both infringement and validity, and its grant of a permanent injunction.

AFFIRMED

Appendix B

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

GEMTRON CORPORATION,

Plaintiff,

-vs-

Case No. 1:04-0387
Hon. AVERN COHN

SAINT-GOBAIN CORPORATION,

Defendant.
_____/

MEMORANDUM AND ORDER DENYING SAINT-GOBAIN'S RULE 50 MOTION FOR JUDGMENT AS A MATTER OF LAW

I. INTRODUCTION

This is a patent case. The patent-in suit, owned by plaintiff Gemtron Corporation (Gemtron), is U.S. Patent No. 6,679,573 B2 (the '573 Patent), which covers a Refrigerator Shelf. On January 28, 2008, a jury, following a four (4) day trial, found the '573 Patent valid. It also found that defendant Saint-Gobain Corporation (Saint-Gobain) infringed Claim 23 of the '573 Patent in the sale in the United States of its model SG16 refrigerator shelf (the SG16). A copy of the Partial Judgment In A Civil Case entered pursuant to the jury verdict is attached as Exhibit A.

Under the Amended Scheduling Order entered January 26, 2007:

- The parties were realigned. The case began with a declaratory judgment complaint filed by Saint-Gobain.

- The '573 Patent was designated the paradigm patent. (U.S. Patent No. 6,422,673-1, covering a Refrigerator Compartment Housing Vertically Adjusting Shelves, was also alleged to infringe.)

- Claim 23 of the '573 Patent was designated the representative claim.

- The SG16 was designated the paradigm product. (Previously models SG1, SG2 and SG3 sold by Saint-Gobain in the United States were found to infringe. See Opinion And Order On Parties' Renewed Motions For Partial Summary Judgment entered April 17, 2006. Also, the Partial Judgment, Exhibit A, describes all of the refrigerator shelves sold by Saint-Gobain in the United States which, according to the jury verdict, infringe Claim 23 of the '573 Patent.)

Under the Pretrial And Scheduling Order entered August 16, 2007, the issues of validity and infringement were bifurcated from the issue of damages. Also, though not recited in any order, the issue of wilfulness was to be tried with the issue of damages.[1]

---

[1] Saint-Gobain was granted summary judgment on the issue of wilfulness. See Memoranda and Order of March 24, 2008 and

Lastly, the defense of enabling disclosure and of written description initially in the case were withdrawn by Saint-Gobain during the instruction conference following the conclusion of the proofs. (See Tr. 01/28/08, p.4).

II. THE PENDING MOTION

A. The Motion

Now before the Court is Saint-Gobain's Rule 50 Motion For Judgment As A Matter Of Law. The text of the motion is highly argumentative. For example, the supplement to Saint-Gobain's brief in support of the motion is styled:

> Saint-Gobain's Supplement To Its Rule 50 Motions Concerning Gemtron's Infringement Theory That There Is No Temperature Limitation In Claim 23 And, Therefore, It Can Cook SG16 In An Oven to Prove Infringement

It is difficult to state the grounds of the motion in a concise fashion. They can be best described by quoting from Saint-Gobain's Reply To Gemtron's Opposition To SaintGobain's Rule 50 Motions For Judgment As A Matter of Law (p. 1) as follows:

> In requesting judgment as a matter of law, plaintiff Saint-Gobain Corporation ("Saint-Gobain") has made four principal

---

Order Denying Motion For Reconsideration of April 3, 2008. The parties eventually agreed on a reasonable royalty rate. The number of infringing shelves and the prices at which they were sold is still to be decided by the Court.

arguments: (1) Gemtron's infringement theory fails, because it is based on evidence that relates to the characteristics of the SG16 shelf when altered after being heated to more than double its normal temperature; (2) Gemtron's infringement theory fails, because it is based on evidence that relates to the characteristics of the SG16 shelf when it is in Mexico, as opposed to in the United States; (3) irrespective of the "heating" and "Mexico" issues, there was no substantial evidence to support the jury's finding of infringement; and (4) at trial, Saint-Gobain proved that claim 23 is obvious and, therefore, invalid, and there was no substantial evidence to support the jury's finding that the '573 Patent is not obvious.

B. The Ruling

As will be discussed, the motion lacks merit. Based on the interpretation of Claim 23 as described in the Order on Claim Construction, as supplemented by the Opinion And Order On Parties' Renewed Motion For Partial Summary Judgment, the proofs at trial were such that the jury could reasonably have found by a preponderance of the evidence that the SG16 infringed Claim 23 of the '573 Patent. Also, the proofs at trial were such that the jury could reasonably have found that they were not clear and convincing regarding the invalidity of Claim 23 of the '573 Patent. Accordingly, there is no good reason to

set aside the jury's verdict and therefore the motion is DENIED.

III. BACKGROUND OF THE CASE BEFORE THE JURY

A. Prior Orders and Decisions

The prior orders and decisions as well as the number of docket entries (over 600) reflect a protracted and contentious case. The significant orders and decisions are as follows:

- Order On Claim Construction - October 3, 2005
- Opinion And Order On Parties' Renewed Motions For Partial Summary Judgment - April 12, 2006 (denying Saint-Gobain's motion and granting Gemtron's motion that the SG1, SG2 and SG3 refrigerator shelves infringe claims 23 to 30 or the '573 patent
- Order On [defendant's] Motion For Reconsideration - April 25, 2006
- Memorandum And Order Denying Motion For Summary Judgment On Issue Of Validity (Obviousness) - December 6, 2007

B. Claim 23

1. The Claim

Claim 23 describes a refrigerator shelf that is constructed from a frame made of synthetic material and a panel of glass. The claim reads:

A refrigerator shelf comprising:

A. a one-piece open frame made of substantially homogeneous polymeric/copolymeric molded synthetic material and a piece of glass closing an opening defined by said frame;

B. said open frame having opposite substantially parallel side frame portions and opposite substantially parallel front and rear frame portions; said glass piece having opposite substantially parallel side edges and opposite substantially parallel front and rear edges;

C. said side, front and rear frame portions being substantially contiguous to said respective side, front and rear edges;

D. each of said side frame portions being defined by

i. an upper wall,

ii. a side wall depending from each upper wall and

iii. a lower wall projecting from its side wall toward an opposite side wall

iv. with the opposing lower walls being spaced from each other

and each defining with an associated upper wall a glass piece side edge-receiving channel, each upper wall and lower wall having a terminal free edge,

v. said glass piece side edges being spaced a predetermined distance from each other,

vi. said upper wall terminal free edges being spaced a predetermined distance from each other,

vii. said lower wall terminal free edges being spaced a predetermined distance from each other,

viii. the predetermined distance of the glass piece side edges being appreciably greater than the predetermined distance of said upper wall edges and only slightly greater than the predetermined distance between said lower wall terminal free edges whereby said glass piece side edges are captively retained in said glass piece side edge-receiving channels, and

E. at least one lower wall of at least one of said front and rear frame portions including a relatively resilient end edge portion which temporarily deflects and subsequently rebounds to snap-secure one of said glass piece front and rear edges in the glass piece edge-receiving channel of said at least one front and rear frame portion.

2. Interpretation

The parties agree that the only element of Claim 23 on which they disagree is the phrase:

> relatively resilient end edge portion which temporarily deflects and subsequently rebounds to snap-secure.

Gemtron contends that the phrase should be interpreted as follows:

> The end edge portion is physically characterized by being relatively resilient such that it can temporarily deflect and subsequently rebound, when glass is being inserted into the frame, to snap-secure the glass into the frame.

Saint-Gobain contends that the phrase should be interpreted as follows:

> The end edge portion is sufficiently flexible to permit the glass in the

> finished product to be pushed out of the frame and pushed back into the frame.

The Court, after a reasoned discussion of the contending positions, interpreted the phrase as follows:

> Based upon the foregoing, the Court interprets the relevant claim language – "*relatively resilient end edge portion which temporarily deflects and subsequently rebounds to snap-secure*" – as follows: the end edge portion is sufficiently resilient that it can temporarily deflect and subsequently rebound when glass is being inserted into the frame.

This interpretation was supplemented in the Opinion and Order on Parties' Renewed Motion for Partial Summary Judgment as reflected in the following excerpt from the Opinion:

> Saint-Gobain argues that the Miedema[2] test is "bogus" because it involved the application of heat to the plastic frames of the Saint-Gobain shelves. According to Saint-Gobain, the testing previously suggested by the court did not contemplate heating the frame.

---

[2] Miedema was Gemtron's expert. As the predicate for his opinion, he heated a SG16. While the shelf was in its heated state, he removed the glass panel and then reinserted and secured it in a manner which he described as snap-securing the glass in the frame.

Moreover, according to Saint-Gobain, a test in which the shelf is heated is not a proper test of the product as it is sold and used.

* * *

. . .the question is solely whether the accused frames are able to temporarily deflect and subsequently rebound when glass is being inserted at *any* temperature. Even though the patent for Gemtron's shelf contemplates an ultimate use within the fresh food or freezer compartment of a refrigerator, the asserted claims themselves contain no temperature limitation and the characteristic of relatively resiliency is defined solely with respect to the ability to insert glass into the frame, which could only occur while the shelf is not in use. The court cannot read a temperature limitation into the claim which is not contained in the claim language.

* * *

Saint-Gobain has, in its motion, demonstrated non-infringement only at a single temperature. However, the asserted claims do not limit the temperature at which relative resiliency – as construed by the court – is present. Gemtron has demonstrated that

> conditions exist under which Saint-Gobain's shelves have the relatively resilient characteristic contained.

The absence of a temperature limitation in Claim 23 was emphasized in the Court's Order on Plaintiff's Motion For Reconsideration as follows:

> As this Court noted in its April 17, 2006 decision, the relevant characteristic of Gemtron's patent is defined in terms of the time the glass is inserted into the frame but not with reference to any particular temperature. The function of the shelf is not at issue, but rather the resilience of the frame at the time the glass is inserted. The relevant claim language, properly construed, contains no temperature limitation. Moreover, Saint-Gobain has not disputed that its shelves are made from a thermoplastic material, which is by definition capable of being repeatedly reheated and reshaped without losing its characteristics. See Oxford English Dictionary Online (2d ed. 1989), http://dictionary.oed.com (Defining "thermoplastic" as "becoming soft when heated and rigid when allowed to cool, and capable of being repeatedly reheated and reshaped without loss of properties; made of such a substance"). In summary, nothing in the High Tech case compels a different result in this case.

IV. THE TRIAL

The trial extended over four (4) days, two (2) days of which were directed to the evidentiary proofs.

A. Witnesses

1. Gemtron

- Mark Delp – Executive Vice President of Gemtron. He described Gemtron and its ownership of the '573 Patent.

- Jorge Merino (deposition) – an industrial engineer employed by Saint-Gobain in Mexico. He described the manufacturing of the SG16.

- Greg Miedema – an expert. He expressed the opinion that the SG16 infringed Claim 23 of the '573 Patent. He took an SG16, heated it, removed the glass panel, reinserted it in the frame, and then secured it. He displayed a video of his actions as well as photographs. He analogized what he did to come to the conclusion the glass panel was snap-secured to what was displayed in the video of the manufacture of the SG16 in Mexico described below.

- Francois Vardon (deposition) – general director of Saint-Gobain's Mexican facility and designer of the SG16. He described his familiarity with the '573 Patent and the manufacture of the SG16. He was the author of Plaintiff's Exhibit 38, a presentation concerning the operations at Saint-Gobain's Mexican facility.

- Steven Gendell - a French language translator.

- Roger Hamilton (in rebuttal) – an expert with familiarity in the design of refrigerator shelves. He expressed the opinion that the '573 Patent was non-obvious in light of prior art.

2. Saint-Gobain

- Jorge Merino (live) – he described the manufacture of the SG16 and the manner in which the glass was inserted in the frame and the manner in which it was secured.

- Dr. Henry W. Stall – an expert. He expressed the opinion that the SG16 did not infringe Claim 23 of the '573 Patent and that the '573 Patent was obvious in light of the prior art.

B. Exhibits

Many exhibits were introduced in evidence. The exhibits included patents, shelves, frames, brochures, manufacturing specifications, drawings, videos of simulations, and a video displaying the manufacture of the SG16 and photographs. Of particular significance were Exhibit 124, a video of the manufacture of the SG16 in Saint-Gobain's Mexico plant; Exhibit 38, a commentary on a new Saint-Gobain shelf; and Exhibit 549, illustrated instructions for assembling the SG16. A copy of Exhibit 549 is attached as Exhibit B.

Exhibit 124 displays an operator taking a frame off of an injection molding machine at an elevated temperature, inserting a glass panel into the frame, deflecting fingers along the edge of the frame as the

glass panel was being inserted, and the fingers rebounding to snap the glass in the frame.

Exhibit 38, a Saint-Gobain document describing a new shelf, is in French. Gendell translated the French word "dipsage" to mean "snap-on." The phrase in which it was used was translated by Gendell (Tr. 01/23/08, p. 170) as follows:

> for the development of a bold and original joining process enabling the assembly of glass and plastic through snap-on installation, which possesses several industrial advantages.

Gendell was vigorously cross-examined. The credibility of his translation was for the jury to decide.

V. THE LAW

A. Judgment As A Matter Of Law

The law on a motion for judgment as a matter of law is well known. The Court recently stated the law as follows:

> Fed.R.Civ.P. 50 provides the following standard for granting judgment as a matter of law:
>
> > If during a trial by jury a party has been fully heard on an issue and there is no legally sufficient evidentiary basis for a reasonable jury to find for that party on that issue, the court may determine the

> issue against that party and may grant a motion for judgment as a matter of law against that party with respect to a claim or defense that cannot under the controlling law be maintained or defeated without a favorable finding on that issue.

Fed.R.Civ.P. 50(a)(1). In addition, when a party makes a renewed motion after a verdict has been returned, the court may: "(A) allow the judgment to stand, (B) order a new trial, or (C) direct entry of judgment as a matter of law[.]" Fed.R.Civ.P. 50(b)(1). The inquiry for resolving a Rule 50 motion for judgment as a matter of law is the same as the inquiry for resolving a motion for summary judgment under Fed.R.Civ.P. 56. White v. Burlington N. & Santa Fe Ry. Co., 364 F.3d 789, 794 (5th Cir. 2004) (en banc) (citing Reeves v. Sanderson Plumbing Prods., Inc., 530 U.S. 133, 150 (2000). That is, "[j]udgment as a matter of law is appropriate when 'viewing the evidence in the light most favorable to the non-moving party, there is no genuine issue of material fact for the jury, and reasonable minds could come to but one conclusion in favor of the moving party.'" Tisdale v. Fed. Express Corp., 415 F.3d 516, 527 (6th Cir. 2005) (internal quotation marks omitted). See also

Johnson Controls v. Jay Ind., ___ F.3d ___, 2006 WL 2380827 (6th Cir. Aug. 18, 2006).

Sundance, Inc. v. DeMonte Fabricating, Ltd., 2006 WL 2708541, at *2 (E.D. Mich. Sept. 20, 2006); see also Sundance, Inc. v. DeMonte Fabricating, Ltd., 485 F. Supp. 2d 805, 809-10 (E.D. Mich.).

B. Instructions

The instructions stated the law applicable to the issues to be decided by the jury.

1. Interpretation of Claim 23

The jury was instructed as to the meaning of Claim 23 as follows:

> Near the end of claim 23 is an element that was mentioned often in the trial: a relatively resilient end edge portion which temporarily deflects and subsequently rebounds to snap-secure. The claim language "a relatively resilient end edge portion which temporarily deflects and subsequently rebounds to snap-secure" means that "the end portion is sufficiently resilient that it can temporarily deflect and subsequently rebound when glass is being inserted into the frame."
>
> Claim 23 does not place any limitation on what the temperature of the frame has to be when the glass is inserted.

2. Infringement

As to infringement the jury was instructed:[3]

> In this case, Gemtron has alleged that Saint-Gobain directly infringes claim 23 of the '573 patent.
>
> In order to prove infringement, Gemtron must prove the requirements for this type of infringement are met by a preponderance of the evidence, *i.e.*, that it is more likely than not that all of the requirements of direct infringement have been proved.
>
> A company directly infringes a claim if, during the time the patent is in force, the company makes, uses, sells, or offers to sell within, or imports into, the United States a product that meets all of the requirements of the claim and does so without the permission of the patent holder. There is no dispute over the fact that the SG16 shelf was sold or used in the United States. To determine whether a particular product meets all of the requirements of a claim, you must understand the meaning of the words in the claim and the requirements that these words impose. I have already

---

[3] Saint-Gobain's challenge to the instructions which were rejected by the Court are the subject of Saint-Gobain's motion for a new trial. This motion was denied by the Court in a Memorandum and Order of even date.

explained to you the meaning of some of the words of the claims in this case. I have also explained to you that other words in the claims should be given their plain English meaning. You must compare the product with each and every one of the requirements of claim 23 of the '573 patent to determine whether all of the requirements of that claim are met. When the product meets all of the requirements of a claim, the product is said to "literally infringe" that claim. If a product that literally infringes a claim is made, used, sold, offered for sale within, or imported into, the United States during the time the patent is in force, without Gemtron's authorization, it directly infringes the claim.

In order to prove direct infringement by literal infringement, Gemtron must prove that the above requirements are met by a preponderance of the evidence, *i.e.*, that it is more likely than not that the SG16 shelf meets all of the requirements of claim 23 of the '573 patent.

3. Invalidity

As to invalidity the jury was told:

To prove that claim 23 is invalid, Saint-Gobain must persuade you by clear and

convincing evidence. That is, in order to find claim 23 invalid you must be left with a clear conviction that the claim is invalid.

4. Obviousness

As to obviousness the jury was told:

Even though an invention may not have been identically disclosed or described before it was made by an inventor, in order to be patentable the invention must also not have been obvious to a person of ordinary skill in the field of technology of the patent at the time the invention was made.

Saint-Gobain may establish that claim 23 is invalid by showing, by clear and convincing evidence, that the claimed invention would have been obvious to persons of ordinary skill in the art at the time the invention was made. For claim 23 to be invalid because it would have been obvious you must first evaluate the following factors:

(1) What is the scope and content of the prior art;

(2) What are the differences, if any, between the invention and the prior art;

(3) What was the level of ordinary skill in the art at the time the invention was made; and

(4) What evidence is there, if any, of certain additional considerations relating to the obviousness or non-obviousness of the invention?

You must decide, in view of the evidence presented to you on these factors, whether or not the invention, considered as a whole, would have been obvious to one having ordinary skill in the art at the time the invention was made.

Before doing so, however, you must keep in mind that it is not permissible to use hindsight in assessing whether the invention is invalid for obviousness. You cannot look at the invention knowing what persons of ordinary skill in the art know today. Rather, you must place yourself in the shoes of a person having ordinary skill in the field of technology of the patent at the time the invention was made.

In this case, Saint-Gobain contends that the inventions are obvious in view of a combination of more than one "prior art" reference. In placing yourself in the shoes of a person having ordinary skill in the field of technology relevant to this case at the time the invention was made, you may

also consider whether such a person would have been motivated to combine these prior art references in order to arrive at the claimed invention.

The first question you must answer in determining whether or not the invention was obvious is the scope and content of the prior art at the time the invention was made. You must decide whether specific references relied upon in this case are "prior art" to the invention described in claim 23 of the '573 patent.

"Prior art" includes previous devices, articles and methods that were offered for sale, printed publications or patents that disclose the invention or elements of the invention. Once you decide whether or not specific references are prior art, you must also decide what those references would have disclosed or taught to one having ordinary skill in the field of technology of the patent at the time the invention was made.

In order for a reference to be relevant for you to consider in deciding whether or not the claimed invention would have been obvious, the reference must be within the field of the inventor's endeavor, or if it is from another field of endeavor, the reference must be reasonably related to the particular problem or issue the inventor faced or addressed when making

the invention described in claim 23 of the '573 patent. A reference from a field of endeavor other than the inventor's is reasonably related to the problems or issues the inventor faced if the reference is one which, because of the matter with which the reference deals, logically would have commended itself to the attention of the inventor when considering the problems or issues he faced in this case. It is for you to decide what the problems or issues were that the inventor faced at the time the invention in claim 23 was made.

The second question you must answer in determining whether or not the invention was obvious at the time it was made is what differences there are, if any, between the prior art and the patented invention. In analyzing this issue, do not focus solely on the differences between the prior art and the invention because the test is not whether there are differences. Rather, the test is whether or not the invention, as a whole, would have been obvious to one having ordinary skill in view of all the prior art at the time the invention was made.

In this case, Saint-Gobain contends that the invention would have been obvious over a combination of known prior art.

In determining whether or not the invention would have been obvious to one

of ordinary skill in the art at the time the invention was made, you must consider whether or not the combination is more than the predictable use of prior art elements according to their established functions. In answering this question, it will often be necessary to consider: any apparent reason to combine the known elements in the manner of the patent claim; teachings of multiple references; the effects of demands that were known to the community or that were present in the marketplace; and the background knowledge possessed by persons of ordinary skill in the art.

To find by clear and convincing evidence that the invention would have been obvious, it is important for you to identify a reason that would have prompted a person of ordinary skill in the art to combine the elements as the invention does. Advances that would have occurred anyway in the ordinary course of development of the art may have been obvious but you need not limit your consideration to the same problem or same prior art elements, or same solution adopted by the inventor. You should consider the level of common sense and creativity of persons of ordinary skill in the art, that familiar items may have obvious uses beyond their primary purposes, and that a person of ordinary skill in the art may be able to fit the teachings of multiple

patents and/or references together like the pieces of a puzzle.

The reason to select and combine features, the predictability of the results of doing so, and a reasonable expectation of success may be found in the teachings of the prior art references themselves, in the nature of any need or problem in the field that was addressed by the patent, in the knowledge of persons having ordinary skill in the field at the time, as well as in common sense or the level of creativity exhibited by persons of ordinary skill in the art. There need not be an express or explicit suggestion to combine references.

C. Source of the Instructions

The instructions were drawn from the Court's decision in Sundance, supra, and the Federal Circuit Bar Association Model Patent Jury Instructions (last edited January 12, 2008).

VI. INFRINGEMENT

A. Alteration of the SG16 By Heating

Saint-Gobain first argues that the characteristics of the SG16 were altered by heating an exemplar to twice its normal temperature to establish infringement. This has reference to the manner in which Miedema came to the conclusion in support of Gemtron's motion for summary judgment that the SG1, SG2, and SG3 infringed Claim 23. Miedema also testified to this effort at trial (see p. 8, supra).

Miedema did not alter the SG16 when, in Saint-Gobain's words, he "cooked" it in an oven. What Miedema did was attempt to replicate the manufacture of the SG16 as he understood it: the glass being inserted and secured in the frame at an elevated temperature. The heated environment was intended to illustrate the condition which exists when the shelf is assembled. Had the video of the manufacturing process in Mexico, Plaintiff's Exhibit 124, been available to Miedema initially, there would have been no need for his experimentation.

The persistent effort of Saint-Gobain to ridicule what Miedema did was at best an effort to confuse.

B. Characteristics In Mexico Not Reflected In The United States

Saint-Gobain also argued that the conditions under which the SG16 is manufactured in Mexico do not obtain in the United States because in the United States the SG16 is rigid and inflexible. This argument was previously dealt with in the claim construction phase of the case. Again, this repeats Saint-Gobain's effort to insert a temperature limitation into Claim 23.

As manufactured, the SG16 has a relatively resilient end edge portion which temporarily deflects and subsequently rebounds to snap-secure the front rear edges of the glass panel. This characteristic still obtains when the SG16 is sold in the United States.

Saint-Gobain essentially argues that when the SG16 is imported into the United States from Mexico, the frame is rigid and therefore must be heated to

prove infringement. This argument was rejected in the claim interpretation phase of this case. As to the fact that the SG16 is manufactured in Mexico and sold in the United States some additional comment is in order.

In Biotec Biologische Naturverurpackungen GmbH & Co. KG v. Biocorp, Inc., 249 F.3d 1341, 1350 (Fed. Cir. 2001), the court held:

> Infringement of product claims by an imported product requires that the product be viewed in the form in which it is present within the United States. See 35 U.S.C. §271(a) ("whoever without authority makes, uses, offers to sell, or sells any patented invention, within the United States" infringes the patent). However, evidence of foreign activities may be relevant to determination of infringement upon importation.

Here the snap-secure element as interpreted by the Court requires that this characteristic be present in the SG16 in the form in which it is used. The proofs established that as manufactured it retained this characteristic in the form in which it was present in the United States, since its temperature while in the United States is not restricted by the claim language.

Saint-Gobain argues that the snap-secure element does not exist in the SG16 as it is present in the United States because applying heat to the frame to prove infringement is a modification or change

which takes the SG16 outside the limitations of the claim. This argument focuses solely on Miedema's opinion in the summary judgment phase, before he observed the video of the manufacture of the SG16 in Mexico.

Saint-Gobain repeatedly cites three (3) cases which it says display fact analogies to what Miedema did: Orinco Corp. v. Align Technology, Inc., 463 F3d 1299 (Fed Cir 2006); In re Buszard, 504 F3d 1364 (Fed Cir 2007) and High Tech Medical Instrumentation v. New Image Industries, 49 F3d 1551 (Fed Cir 1995). They do not support Saint-Gobain's argument. In each of these cases the accused product, contrary to what is present here, was altered or changed in the effort to prove infringement.

In Orinco, the accused product was an orthodontic device. A claim construction that would "merely require that infringing devices be capable of being modified to conform to a specified claim limitation," 463 F.3d at 1307, was rejected. Here the SG16 was not modified to establish infringement of Claim 23. The snap-secure element is present in the SG16 at all times.

In Buszard, a claim was rejected by the Patent Office as anticipated by a particular reference. The finding of the Patent Office was reversed. The Federal Circuit said:

> Buszard's specification and claims specifically state the requirement of a flexible polyurethane foam reaction mixture. No matter how broadly "flexible

> foam reaction mixture" is construed, it is not a rigid foam reaction mixture. The Eling reference describes only a rigid foam reaction mixture that produces a rigid product. Only by mechanically crushing the rigid product into small particles is it rendered flexible, as a rock can be mechanically crushed to produce particles of sand. This description cannot reasonably be construed to describe, and thus to "anticipate," the flexible foam product of a flexible foam reaction mixture. We agree with Buszard that it is not a reasonable claim interpretation to equate "flexible" with "rigid," or to equate a crushed rigid polyurethane foam with a flexible polyurethane foam.

504 F.3d at 1367.

Here again, the application of heat to demonstrate infringement was not out of order; there is no temperature limitation called for by the claim language.

In High Tech the asserted claim in an infringement action was a endoscopic optical device which included a rotatable camera which could rotate if two (2) sets of screws were loosened. In rejecting a finding of infringement by the district court, the Federal Circuit said:

> In the AcuCam, as designed, sold, and intended for use, the camera is rigidly coupled to its housing. The original and

> intended operating configuration of the device must be altered– by loosening the set screws – in order for the camera to rotate.
>
> The district court found a likelihood of infringement based on its conclusion that, but for the set screws, "the camera is otherwise coupled to the body member in such a manner that it is capable of being rotated." But a device does not infringe simply because it is possible to alter it in a way that would satisfy all the limitations of a patent claim.

49 F.3d at 1555.

To repeat: the SG16 was not altered to prove infringement.

C. Evidence of Infringement at Trial

Moving beyond the "heating" and "Mexico" arguments, Saint-Gobain takes issue with the jury's finding of infringement. As noted, in assessing the sufficiency of the evidence to support the jury's finding of infringement, the Court does not weigh the evidence or assess its credibility.

Here internal Saint-Gobain documents, the display of the manufacturing process, and Miedema's testimony offer ample evidence to support the finding of infringement.

Miedema's testimony alone is sufficient. Miedema examined the SG16, reviewed the

manufacturing process, examined Saint-Gobain's internal documents, developed test procedures to determine if the glass was snap-secured in the frame, described the characteristics of the SG16, and found all the elements of Claim 23 in the SG16. On this foundation, he expressed the opinion that the glass panel was snapped into place in the manner called for by Claim 23.

Saint-Gobain made much of the fact that one of the shelves Miedema tested broke when he attempted to insert and secure the glass panel. His explanation, which the jury could have found credible, was that he was attempting to determine the temperature at which the frame would snap-secure the frame in place. The fact that a shelf broke did not change his opinion. Miedema was vigorously cross-examined. The jury in finding infringement obviously did not give weight to the "broken shelf" argument.

In sum, the evidence was sufficient for the jury to find by a preponderance that Saint-Gobain assembled the SG16 by pressing the glass panel against and past the plastic frame relatively resilient end portion, thereby snap-securing, as that phrase is interpreted by the Court, the glass to the frame.

VII. INVALIDITY

Saint-Gobain's argument that there was clear and convincing evidence at trial supporting a finding that Claim 23 was invalid has no merit. The evidence at trial on the validity issue was essentially a reprise of the evidence put to the Court by the parties in its consideration of Saint-Gobain's motion for summary

judgment on the issue of validity on the grounds of obviousness. All this is described in the Memorandum And Order Denying Motion For Summary Judgment On Issue of Validity referenced above, and reported at 2007 WL 4534780 (W.D. Mich. Dec. 6, 2007). Hamilton's opinion evidence on the issue, however, bears repeating.

Hamilton testified as to his experience in designing refrigerator in his career as an engineer. He examined prior art refrigerator shelves as well as various types of snap fits, all of which he described in detail. In the prior art, the refrigerator shelves encapsulated the glass panel. The glass panel was inserted in a frame as part of the molding process. A plastic was injected around the edge to secure the frame to the glass panel. Hamilton also described various forms of snap fits. Hamilton concluded that based on his experience in designing refrigerator shelves and the prior art references, it would not be obvious to one skilled in the art (there was no disagreement on who that was) to combine the references and come up with the refrigerator shelf described in Claim 23.

Stall, Saint-Gobain's expert, while expressing an obviousness opinion, did not explain how the snap present in the prior art could be adjusted or adapted to secure a glass panel in a plastic frame to yield the refrigerator shelf described in Claim 23.[4]

---

[4] Saint-Gobain's argument for obviousness reminds the Court of what Abraham Lincoln once said: Saying it doesn't make it so; even if you call a dog's tail a leg, it still has only four legs.

As the Court explained in denying summary judgment to Saint-Gobain, Memorandum, supra at 7:

> Saint-Gobain. . .makes clear that it is relying on the first rationale of the Patent Office Guidelines, namely that it is obvious to combine elements known in the prior art according to known methods to yield predictable results. The facts [in evidence]. . .do not support a finding that there is a *reason to combine* the prior art reference to yield predictable results in the fashion called for by Claim 23. While the prior art displays snap-securing, the references Saint-Gobain relies on are so far different than the snap-securing element of Claim 23 that it cannot be said that nothing more than a "known technique" to a new use is present. Saint-Gobain has not identified a reason for a person of ordinary skill in the art to combine the elements in the prior art in the manner called for by Claim 23.
>
> The [expert] on which Saint-Gobain rely offer only conclusionary opinions.
>
> ***
>
> Claim 23 calls for the edge portion of the plastic frame to move out of the way and then come back to snap the glass; the snap feature is integrated with the

> frame. Nothing in the prior art suggests this.

In denying Saint-Gobain's motion for summary judgment, the Court said:

> What the denial [of the motion] says is that at this juncture of the case it is for a jury to decide.

The jury decided that it was not obvious to one skilled in the art to combine the prior art references to come up with Claim 23. The '573 Patent was not proved invalid.

VIII. CONCLUSION

While there are still open issues to be resolved, the basics of this case, validity and infringement, are now concluded. The case really should have concluded with the finding that the SG1, SG2, and SG3 infringed the '573 Patent. Why it started up again when the SG16 came to light has not really been explained. There was never a good argument for invalidity even after KSR was decided. See KSR v. Teleflex, 500 U.S. __, 127 S.Ct. 1727 (2007). The issue has always been infringement.

As in many patent cases, a finding of infringement stems from how the claim-in-suit is construed. Once Claim 23 was construed not to call for a particular temperature, the issue of infringement was never a serious one. Unfortunately because Miedema was denied full access to Saint-Gobain's manufacturing process, it was inevitable that he would ultimately have to formulate his

opinion by reverse engineering the Saint-Gobain shelf. This led to Saint-Gobain's specious argument that "cooking" established non-infringement. "Cooking" was a red herring. Unfortunately, it took over two (2) years to take the color out of the herring. Be that as it may, the Court can now say finé (almost) to this case.

SO ORDERED.

Dated: April 21, 2008

s/ Avern Cohn
AVERN COHN
UNITED STATES
DISTRICT JUDGE

I hereby certify that a copy of the foregoing document was mailed to the attorneys of record on this date, April 21, 2008, by electronic and/or ordinary mail.

s/Julie Owens
Case Manager, (313) 234-5160

Appendix C

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF MICHIGAN
SOUTHERN DIVISION

SAINT-GOBAIN CORPORATION,

Plaintiff, Case No. 1:04-cv-387

v Hon. Wendell A. Miles

GEMTRON CORPORATION,

Defendant.
_____/

OPINION AND ORDER
ON PARTIES' RENEWED MOTIONS FOR PARTIAL SUMMARY JUDGMENT

At issue in this action are two patents owned by defendant, Gemtron Corporation. Currently before the court are the following motions for summary judgment filed by both parties: (1) "Plaintiff Saint-Gobain's Motion for Summary Judgment of Non-Infringement Based Upon the Test Set Forth in the Court's October 24, 2005 Opinion and Order on Motions for Summary Judgment" (docket no. 145), and (2) "Gemtron Corporation's Second Motion for Summary Judgment as to Infringement" (docket no. 157).[5]

[5] Saint-Gobain has filed a separate "Motion for Oral Argument"

For the reasons to follow, the court **DENIES** Saint-Gobain's motion and **GRANTS** Gemtron's motion.

I

Gemtron is the owner of United States Patent Nos. 6,422,673 ("the '673 patent") and 6,679,573 ("the '573 patent") (collectively "the patents" or "both patents"). The '673 patent, issued on July 23, 2002, is directed to a "REFRIGERATOR COMPARTMENT HOUSING VERTICALLY ADJUSTABLE SHELVES, EACH FORMED FROM A PIECE OF TEMPERED GLASS SNAPPED-FASTENED TO AN INJECTION MOLDED FRAME." The '573 patent, issued on January 20, 2004, is, in contrast, directed merely to a "REFRIGERATOR SHELF." To put it more simply, the '673 patent is directed to a refrigerator compartment having adjustable shelves both supported and held in place by ribs or ledges, while the '573 patent is directed to the refrigerator shelf itself, which is composed of a frame made of molded synthetic material enclosing a snap-in glass panel.

(docket no. 227) on both parties' motions. Gemtron has opposed the scheduling of oral argument on the motions.

In this district, requests for oral argument are not made by separate motion. This court's local rules provide that any party desiring oral argument with respect to a dispositive motion shall include a request in the caption and heading of its brief and that the court, in its discretion, may either schedule oral argument or dispose of the motion at the end of the briefing schedule. W.D. Mich. L. Civ. R. 7.2(d). At this point, both motions have been fully briefed and the court has determined that oral argument will not materially aid the court in its resolution of the motions.

In its Amended Complaint (docket no. 238), Saint-Gobain seeks a declaratory judgment of non-infringement and invalidity of both patents. Saint-Gobain has also asserted claims of unfair competition and antitrust violations against Gemtron. In its Counterclaim, Gemtron accuses Saint-Gobain of infringing both patents by manufacturing, using, importing into the United States, and selling refrigerator shelves which incorporate the inventions claimed in the patents. Answer, Affirmative Defenses, and Counterclaim to Amended Complaint (docket no. 251) at 6.

On October 3, 2005, the court issued an Order on Claim Construction (docket no. 113) interpreting the relevant claim language "*relatively resilient end edge portion which temporarily deflects and subsequently rebounds to snap-secure.*" The court concluded that the claim language has the following meaning: **the end edge portion is sufficiently resilient that it can temporarily deflect and subsequently rebound when glass is being inserted into the frame.** Previously, the court also denied motions for summary judgment filed by the parties. Opinion and Order on Motions for Summary Judgment (docket no. 123). In denying the parties' motions, the court noted that neither party had adequately addressed a critical issue, namely, whether glass could be snap-fitted into Saint-Gobain's frame as imported into the United States. Because the Saint-Gobain shelves, as imported into the United States, already have the glass inserted, the court concluded that it would be necessary to remove the glass in order to perform testing to determine whether the frame (or some portion of it)

was sufficiently resilient that the glass (or another identical piece of glass) could be re-inserted or "snap-secured" into the frame. The court denied the motions because the parties had not provided evidence of the results of such testing.

II

In this action, Saint-Gobain has both denied any infringement and maintained that the patents are invalid. However, neither party's motion raises the issue of the validity or invalidity of the patents at the present time.[6] In its motion, Saint-Gobain instead seeks "summary judgment of non-infringement based upon the test set forth" in the court's previous order denying the parties' original motions for summary judgment. In its motion, Gemtron seeks summary judgment in its favor on the issue of whether Saint-Gobain's SG1, SG2, and SG3 refrigerator shelves infringe claims 23-30 of Gemtron's '573 patent.

---

[6] Gemtron's patents are presumed to be valid. 35 U.S.C. § 282; Lisle Corp. v. A.J. Mfg. Co., 398 F.3d 1306, 1313 (Fed. Cir. 2005). The party attacking the patent bears the burden of proving invalidity by clear and convincing evidence. Iron Grip Barbell Co., Inc. v. USA Sports, Inc., 392 F.3d 1317, 1320 (Fed. Cir. 2004); AK Steel Corp. v. Sollac and Ugine, 344 F.3d 1234, 1238-1239 (Fed. Cir. 2003). However, patent infringement and patent validity are treated as separate issues. Pandrol USA, LP v. Airboss Rwy. Prod., Inc., 320 F.3d 1354, 1364 (Fed. Cir. 2003). "Though an invalid claim cannot give rise to liability for infringement, whether it is infringed is an entirely separate question capable of determination without regard to its validity." Medtronic, Inc. v. Cardiac Pacemakers, Inc., 721 F.2d 1563, 1583 (Fed. Cir. 1983).

"As in other cases, the grant of summary judgment under Fed.R.Civ.P. 56, is appropriate in a patent case where no genuine issue of material fact exists and the movant is entitled to judgment as a matter of law." Becton Dickinson and Co. v. C.R. Bard, Inc., 922 F.2d 792, 795 (Fed. Cir. 1990) (footnote omitted). "[T]he plain language of Rule 56(c) mandates the entry of summary judgment, after adequate time for discovery and upon motion, against a party who fails to make a showing sufficient to establish the existence of an element essential to that party's case, and on which that party will bear the burden of proof at trial." Celotex Corp. v. Catrett, 477 U.S. 317, 322-323, 106 S.Ct. 2548, 2552 (1986). In evaluating a motion for summary judgment, the court must determine "whether the evidence presents a sufficient disagreement to require submission to a jury or whether it is so one-sided that one party must prevail as a matter of law." Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 251-52, 106 S.Ct. 2505, 2512 (1986).

Any inferences to be drawn from the underlying facts must be viewed in the light most favorable to the party opposing the motion. Matsushita Elec. Indus. Co., Ltd. v. Zenith Radio Corp., 475 U.S. 574, 587-88, 106 S.Ct. 1348, 1356 (1986). However, while inferences drawn from the underlying facts must be viewed in the light most favorable to the party opposing the motion, "[w]hen the moving party has carried its burden under Rule 56(c), its opponent must do more than simply show that there is some metaphysical doubt as to the material facts." Id., 475 U.S. at 586, 106 S.Ct. at 1356. The applicable substantive law governing the issue determines what

facts are relevant; only factual disputes which may have an effect on the outcome of a lawsuit under the applicable substantive law are deemed "material." Anderson, 477 U.S. at 248.

III

An analysis of whether a patent is infringed involves a two-step determination: (1) determining the meaning and scope of the patent claims allegedly infringed, and (2) comparing the properly construed claims to the accused device. Cybor Corp. v. FAS Technologies, Inc., 138 F.3d 1448, 1454 (Fed. Cir. 1998); Markman v. Westview Instruments, 52 F.3d 967, 976 (Fed. Cir. 1995), aff'd, 517 U.S. 370, 116 S.Ct. 1384 (1996). "[T]he interpretation and construction of patent claims, which define the scope of the patentee's rights under the patent, is a matter of law exclusively for the court." Markman, 52 F.3d at 970-971. Infringement, in contrast, is a question of fact. Pause Technology, LLC v. TiVo, Inc., 419 F.3d 1326, 1329 (Fed. Cir. 2005); Ferguson Beauregard/Logic Controls v. Mega Sys., LLC, 350 F.3d 1327, 1338 (Fed. Cir. 2003); Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc., 289 F.3d 801, 812 (Fed. Cir. 2002). The patent owner has the burden of proving infringement and must meet its burden by a preponderance of the evidence. SmithKline Diagnostics, Inc. v. Helena Lab. Corp., 859 F.2d 878, 889 (Fed. Cir. 1988). In comparing a properly construed claim with the accused product, the second step of the inquiry, the patentee – here, Gemtron – bears the burden of proving by a preponderance of the evidence that every limitation set forth in the asserted claim is found in the accused product, either

literally or by a substantial equivalent. Wolverine World Wide, Inc. v. Nike, Inc., 38 F.3d 1192, 1196 (Fed. Cir. 1994).

Literal infringement requires the patentee to prove that the accused product or device contains each and every limitation set forth in the asserted claim. V-Formation, Inc. v. Benetton Group SpA, 401 F.3d 1307, 1312 (Fed. Cir. 2005); Catalina Mktg., 289 F.3d at 812. Under the doctrine of equivalents, "a product or process that does not literally infringe upon the express terms of a patent claim may nonetheless be found to infringe if there is 'equivalence' between the elements of the accused product or process and the claimed elements of the patented invention." Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co., 520 U.S. 17, 21, 117 S.Ct. 1040, 1045 (1997). "Infringement under the doctrine of equivalents requires that the accused product contain each limitation of the claim or its equivalent." Aquatex Indus., Inc. v. Techniche Solutions, 419 F.3d 1374, 1382 (Fed. Cir. 2005). "An element in the accused product is equivalent to a claim limitation if the differences between the two are insubstantial. The analysis focuses on whether the element in the accused device 'performs substantially the same function in substantially the same way to obtain the same result' as the claim limitation." Id.

In its motion, Gemtron argues that it is clear that Saint-Gobain's refrigerator shelves have the relatively resilient end edge portion and all of the other limitations of at least claims 23-30 of the '573 patent. Gemtron argues that Saint-Gobain's shelves therefore literally infringe claims 23-30 of the patent.

Although Saint-Gobain has not disputed that its shelves meet the other limitations of claims 23-30 of the '573 patent, Saint-Gobain does dispute whether its shelves have the claimed "relatively resilient" characteristic; Saint-Gobain argues that its shelves do not have the characteristic.

The court's Order on Claim Construction interpreted the relevant claim language –"*relatively resilient end edge portion which temporarily deflects and subsequently rebounds to snap-secure*" – as follows: the end edge portion is sufficiently resilient that it can temporarily deflect and subsequently rebound when glass is being inserted into the frame. The question presented by the current motions is whether, based on this construction, a genuine issue of fact remains regarding whether Saint-Gobain's shelves have the claimed characteristic. The court concludes that no genuine issue remains and that the accused shelves do indeed have the claimed characteristic.

Each party has supported its position by submitting the affidavit of an expert. According to Gemtron's expert, Greg Miedema, he has performed testing as a result of which he determined that it is possible to insert glass pieces for all of the SG1, SG2, and SG3 shelves by snap-securing them into the glass-receiving channel of their respective frames. According to Saint-Gobain's expert, Dr. Henry Stoll, he has attempted to fit glass panes for each of the SG1, SG2, and SG3 shelves into the respective frames but has determined that "it is clear" that they "cannot be so fitted."

However, these affidavits do not present a "classic battle of the experts" which would require a jury to evaluate what weight and credibility each expert opinion deserves. See Phillipsv. Cohen, 400 F.3d 388, 399 (6th Cir. 2005) ("competing expert opinions present the 'classic battle of the experts' and it [is] up to a jury to evaluate what weight and credibility each expert opinion deserves") (citation omitted). Here, there is no dispute that the experts performed their testing under different conditions, and that these different conditions account for the differing results. Subsequent to Gemtron's submission of the Miedema affidavit, Saint-Gobain deposed Mr. Miedema. In his testimony, Miedema admitted that he had performed his testing after he had heated the Saint-Gobain frames in an oven. As for Dr. Stoll, during his own deposition he testified that he performed his testing at "room temperature," which turned out to be the temperature of his garage during the month of October. Because the experts' affidavits are not in conflict, the court can and does assume that the information contained in both of the affidavits is true – and Saint-Gobain loses on the infringement issue as a matter of law.

Saint-Gobain argues that the Miedema test is "bogus" because it involved the application of heat to the plastic frames of the Saint-Gobain shelves. According to Saint-Gobain, the testing previously suggested by the court did not contemplate heating the frame. Moreover, according to Saint-Gobain, a test in which the shelf is heated is not a proper test of the product as it is sold and used.

Certainly, "a device does not infringe simply because it is possible to alter it in a way that would satisfy all the limitations of a patent claim." High Tech Medical Instrumentation, Inc. v. New Image Indus., Inc., 49 F.3d 1551, 1555 (Fed. Cir. 1995). However, the Saint-Gobain shelves were not altered; instead, they were heated slightly, to show that the "relatively resilient" characteristic is present when the glass is inserted. The court interpreted the relevant claim language – "*relatively resilient end edge portion which temporarily deflects and subsequently rebounds to snap-secure*" – as follows: the end edge portion is sufficiently resilient that it can ***temporarily deflect and subsequently rebound when glass is being inserted*** into the frame. Thus, the relevant characteristic is defined by the patent in terms of *the time of insertion*, and not the time of actual use in a refrigerator or freezer compartment. For this reason, this case is unlike the hypothetical situation described in Bionx Implants, Inc. v. Linvatec Corp., 299 F.3d 1378, 1382 (Fed. Cir. 2002).

In Bionx Implants, the plaintiff held a patent for a surgical procedure to repair a torn meniscus (part of the human knee joint) and the device employed in that procedure. The plaintiff alleged that the defendant's surgical fastener and the method of using it infringed the plaintiff's patent. At issue was whether the accused device was "rigid" within the meaning of that term as used in the patent. The district court had construed the term "rigid" to require that the claimed suture be sufficiently rigid to be pushed through the meniscus tissue without a pre-cut channel for the suture to follow. 299 F.3d at 1380. In granting summary judgment in favor of the

defendant, the district court discounted the plaintiff's videotaped demonstration of the accused device showing its insertion into uncut meniscal tissue through use of a cannula designed specifically for the demonstration. Citing High Tech, the district court concluded that the demonstration was insufficient to defeat summary judgment "because it ran afoul of 'the well-established rule that a device does not infringe merely because it can be altered to make it infringe.'" Bionx Implants, 299 F.3d at 1382.

The Federal Circuit panel in Bionx, however, held that the use of a cannula during the plaintiff's videotaped demonstration of the accused surgical fastener did not render the demonstration invalid on the ground that it constituted an alteration of the accused device or the context in which the rigidity of the patented device was to be judged. 299 F.3d at 1383-1384. The panel disagreed that the use of the cannula constituted an improper alteration of the accused device analogous to removal of the set screws in High Tech. 299 F.3d at 1382. Although acknowledging that "the accused device would not be shown to be 'rigid' if it were frozen in liquid nitrogen before being inserted into the meniscal tissue, or if it were shot as a high-speed projectile into the meniscus" because these conditions would "differ too dramatically from the conditions contemplated for use of the patented device[,]" the panel held that the use of a cannula to insert the accused device into human tissue was within the context in which the patent contemplated that the claimed invention would be used. 299 F.3d at 1382-1383. The panel's decision therefore vacated the entry of summary judgment in favor of the defendant, on the basis that

the district court's ruling could not rest on the reasoning that the plaintiff's test was invalid. 299 F.3d at 1383.

Here, in contrast, no method of use of the patented product is at issue, and the question is solely whether the accused frames are able to temporarily deflect and subsequently rebound when glass is being inserted at *any* temperature. Even though the patent for Gemtron's shelf contemplates an ultimate use within the fresh food or freezer compartment of a refrigerator, the asserted claims themselves contain no temperature limitation and the characteristic of relatively resiliency is defined solely with respect to the ability to insert glass into the frame, which could only occur while the shelf is not in use. The court cannot read a temperature limitation into the claim which is not contained in the claim language. See, e.g., E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1433 (Fed. Cir.) ("It is entirely proper to use the specification to interpret what the patentee meant by a word or phrase in the claim. . . . But this is not to be confused with adding an extraneous limitation appearing in the specification, which is improper") (citation omitted), cert. denied, 488 U.S. 986, 109 S.Ct. 542 (1988).[7]

---

[7] Of course, the time for claim construction has already passed. However, it is noted that at the relevant time, Saint-Gobain did not argue that the court should construe the term "relatively resilient" with reference to any temperature limitation. See Saint-Gobain's *Markman* Brief (docket no. 57) at 4 (urging a construction of "relatively resilient" as "the end edge portion is sufficiently flexible to permit the glass in the finished product to

Saint-Gobain has not shown or even argued that its frames do not temporarily deflect when glass is being inserted at the temperatures used by Miedema in his tests. Saint-Gobain also does not argue that its frames do not subsequently rebound after the glass is inserted. Moreover, Saint-Gobain has not argued that its shelves do not have all of the other limitations of claims 2330 of the '573 patent. The court therefore concludes that Gemtron is entitled to summary judgment as a matter of law that Saint-Gobain's SG1, SG2, and SG3 refrigerator shelves infringe claims 23-30 of the '573 patent.

Finally, it is noted that Saint-Gobain has, in its motion, sought permission to have Dr. Stoll repeat his room temperature testing live for the court. Gemtron has objected to such a demonstration, arguing that it will add nothing to the court's determination. Saint-Gobain has also argued that Miedema's own demonstration, provided in a DVD submitted with his affidavit by Gemtron in support of its motion, is entitled to "little weight" because it represents an *ex parte* test. However, the cases cited by Saint-Gobain as support for this proposition are not on point here. In re Newman, 782 F.2d 971 (Fed. Cir. 1986) involved testing pursuant to a discovery request under Fed.R.Civ.P. 34. In addition, Wagoner v. Barger, 463 F.2d 1377 (CCPA 1972) involved a patent which described methods for the manufacture of films at specified temperatures. Here, there is no specified temperature(s) and the method or process of manufacture is not at issue. And, in Congoleum Indus., Inc. v. Armstrong Cork Co., 319 F. Supp. 714

---

be pushed out of the frame and pushed back into the frame").

(E.D. Pa. 1970), the court held that it was "proper procedure" for the parties to submit as evidence *at trial* the testimony of experts and other witnesses which fully explained their respective commercial processes (the patents at issue being directed to a process for making chemically embossed foamed vinyl floor coverings) and the test procedures employed. The court in fact denied the defendant's motion to conduct a series of inter partes tests, concluding that "[s]uch a procedure would simply result in a duplication of effort" which would further delay the trial. Id. at 716.

It is undoubtedly proper for the court, in a patent case, to view a demonstration of the accused product as evidence. See Bionx, 299 F.3d at 1383 (district court erred in discounting, as evidence, videotaped demonstration of accused device). However, it is not appropriate, on summary judgment, to conduct an evidentiary hearing for the purpose of observing the demeanor of a witness in the case. Willetts v. Ford Motor Co., 583 F.2d 852, 855 (6th Cir. 1978).[8] The court agrees with Gemtron and concludes that a demonstration – whether live or otherwise[9] – will add

---

[8] The court looks to Sixth Circuit precedent in this situation, which involves a procedural matter not unique to patent law. See Arthur A. Collins, Inc. v. Northern Telecom Ltd., 216 F.3d 1042, 1047-1048 (Fed. Cir. 2000); Glaverbel Societe Anonyme v. Northlake Mktg. & Supply, Inc., 45 F.3d 1550, 1560 n.3 (Fed. Cir. 1995).

[9] In contrast with Gemtron, which has provided the court with a DVD video of Miedema inserting glass into the Saint-Gobain frames, Saint-Gobain has not elected to provide the court with a video demonstration of the testing performed by Dr. Stoll.

nothing here, where it is not the experts' affidavits which are in conflict, but rather the parties' views on the legal relevance of the experts' opinions. Here, Saint-Gobain has not challenged the finding of Gemtron's expert that glass may be inserted into Saint-Gobain's shelves after the application of heat but without permanently altering them.

Conclusion

Saint-Gobain has, in its motion, demonstrated non-infringement only at a single temperature. However, the asserted claims do not limit the temperature at which relative resiliency – as construed by the court – is present. Gemtron has demonstrated that conditions exist under which Saint-Gobain's shelves have the relatively resilient characteristic contained within the construed claims. Therefore, Saint-Gobain is not entitled to summary judgment of non-infringement, and Gemtron is entitled to summary judgment as a matter of law that SaintGobain's SG1, SG2, and SG3 refrigerator shelves infringe claims 23-30 of the '573 patent.

So ordered this 17th day of April, 2006.

/s/ Wendell A. Miles
Wendell A. Miles
Senior U.S. District Judge

Appendix D

United States Court of Appeals for the Federal Circuit

2009-1001

GEMTRON CORPORATION,

Plaintiff-Appellee,

v.

SAINT-GOBAIN CORPORATION,

Defendant-Appellant.

Appealed from the United States District Court for the Western District of Michigan in case no. 1:04-CV-0387, Senior Judge Avern C. Cohn.

ORDER

NOTE: This order is nonprecedential.

A petition for rehearing en banc having been filed by the Appellant, and the matter having first been referred as a petition for rehearing to the panel that heard the appeal, and thereafter the petition for rehearing en banc having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on October 9, 2009.

FOR THE COURT

/s/ Jan Horbaly
Jan Horbaly
Clerk

Dated: 10/02/2009

cc: Arthur I. Neustadt
David L. De Bruin

GEMTRON V SAINT-GOBAIN, 2009-1001
(DCT - 1:04-CV-0387)

FILED
U.S. COURT OF APPEALS FOR
THE FEDERAL CIRCUIT

OCT 02 2009

JAN HORBALY
CLERK